



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,371	06/19/2001	Shuji Shichi	PNDF-01078	1070
466	7590	07/19/2007		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER DASS, HARISH T	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/883,371	SHICHI, SHUJI	
	Examiner	Art Unit	
	Harish T. Dass	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejected claims cover every conceivable product. Particularly, "sequential" and "sequentially" can not be found in original specification.

Note: Applicant either provide support for these words in original specification or remove the limitations.

Examiner has not analyzed every amended limitation with respect to the 35 USC 112 1st paragraph for new matter. In response to this office action Applicant should add a note that no new matter is added and preferably to speed the prosecution provide page numbers of original specification for added limitation.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3693

Claims 16-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, C) executing another action chain including sequentially is not clear. Provide an example and portion of specification which explains this limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-21 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwan (US 2003/0200179) in view of Parrillo (US 5,239,583).

Re. Claim 16, Kwan discloses prepaid card and a method for making payment to merchant through electronic network to settle a transaction [Abstract; Figures 2-3],

A) providing a user with a prepaid card linked to a database [Figure 5; paragraphs (para.) 04, 06 "is instantaneous and there I no waiting period like ... is already pre-paid." Mean settled; para. 20]; and

B) executing a first action chain for immediately settling a data sale including sequentially [Figures 2-3; para. 06 "There are many ... users to make payment ...

already pre-paid”; para. 61 “at step 270, the ... the amount is accepted” and “Thank you for your payment “Merchant” of 50 dollars ... You have 40 dollars balance ... pre-paid card” means settling the sale/payment].

i) the user inputting a password number [para. 21; 32-33],

ii) a first validation of the prepaid card by comparing the user-input password number to a system-set first-time password number stored on the database as the current password number [Figures 3-5; claim 5 (see verifying the password identification code, new users to select a unique password); para. 21, para. 60-61 see “It will check to see if the customer’s payment code (payment code or pre-paid card password). It is obvious that there is a first time password either set by system administrator or customer/merchant, where in case of administrator’s set-password, it is encouraged to be changed.],

iv) requesting a current monetary balance available on the prepaid card [claim 5; para. 32-33 (inputting queries)]

C) executing another action chain including sequentially and wherein step C) is repeated [see Abstract “This is a pre-paid card system to store monetary value and subsequently for making payment to merchants”; Figures 2-3; see Figure 3 for sequence of steps including “You have 40 dollars balance” which can be used for another transaction – repeating is inherently in Kwan (making payments to other merchants using the same card)],

Kwan does not explicitly disclose

iii) the user entering a next-time password number and storing the user-input next-time password number in the database as a new user-set password number,

ii) validation of the prepaid card by a successful comparison of the user-input another password number to the stored new, user-set next-time password,

iii) the user entering another next-time password number and storing the user-input another next-time password in the database as the new, user-set next-time password number required for validation of the prepaid card in a next another action chain.

However, inputting or entering password, validation of passwords and changing the passwords are well known to protect unauthorized use of computer accounts, credit cards, and debit cards. For example (will-known), a bank customer who has opened an account with a bank receives a debit card (credit card, IC card, or smart card) by mail and a temporary password or PIN (separately mailed by the bank), customer activates the card (using ATM, PC or phone)¹ and changes the PIN (initial password or first time password) to new PIN (password) and now the new PIN is activated and can be used for next transaction. It is known that validation of password (current password, next-time password, etc) is comparing the inputted password with record of password associated with user id in database, and changing password mean changing the record of password in the database using SQL. Example 2; a bank account customer making a payment using Internet, 1) customer using bank's URL/portal opens the bank web page, 2) from site menu selects service and logs to online banking by entering user id and

password, 3) selects his account and bill payment menu and makes payment 4) before/after making payments (step 3) customer has an option to change his/her password if or she wants, 5) logs off, 6) for next time login, he/she has to use new password, 7) these sequence of steps 1-6 can be repeated for next bill payment.

Further, customer is free to change his/her PIN any time he/she wants before transaction/checking emails or after it is personal preference or business choice, a very careful person may change it every 15 days or a month and a paranoid person may change it every other usage. At USPTO user password must be change within 3 months, dynamic RSA SecurID token changes the password continuously, every minute which means user logs-in with current password which is different than a password a minute before it and it will be different from a password the next minute. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan and include provisioning for changing password as often as use wishes and ant any time before a bill payment/checking email or after it to increase the security of the password protection.

Parrillo discloses iii) the user entering a next-time password number and storing the user-input next-time password number in the database as a new user-set password number, ii) validation of the prepaid card by a successful comparison of the user-input another password number to the stored new, user-set next-time password, iii) the user entering another next-time password number and storing the user-input another next-time password in the database as the new, user-set next-time password number

¹ Comparing the pin/password with database for authentication/validation and storing of the new

Art Unit: 3693

required for validation of the prepaid card in a next another action chain [Abstract; col. 2 lines 10-46; col. 3 line 58 to col. 4 line 25 also col. 6 lines 26-50 and claim 1]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan and include the above steps to allow the users to change password as often as he/she wishes at any time including for next transaction, as it is disclosed by Parrillo, to prevent usage of card by unauthorized user observing a successful transaction where the subsequent duplication of that exact same access code would result in failure to access the account and enhance the security of the pre-paid card usage.

Re. Claim 17, Kwan discloses wherein the prepaid card is a virtual card [para 09; 05; 18].

Re. Claim 18, Kwan discloses the prepaid card comprises a physical card carrying duplicate information carried in the database, the prepaid card comprises a serial number, the first-time password number, and an expiration date printed on an exterior surface of the physical card, and the database comprises the serial number, the first-time password number, and the expiration date of the prepaid card [Figure 1; para 21; 63; claim 1]

Re. Claim 19, Kwan discloses the first-time password number is concealed below of scratch-off covering [Figure 5; para 21].

Re. Claim 20 Kwan discloses the database includes a database record corresponding to the prepaid card and comprising a serial number field storing a system-assigned serial number, a first-time password number field storing the system-assigned first-time password number used for a first time validation of the prepaid card, and a user-set password number field for storing the user-set next-time password number (password) reset by the user subsequent to each validation of the prepaid card, a monetary balance field storing a monetary balance available to the user [Figures 2-3; para. 19-21; claim 8;], and comprising the further step of: subsequent to the validation of the prepaid card, a action of subtracting a price being necessary for distribution from monetary balance field to update the monetary balance field by reducing a value of the monetary balance field by the price being subtracted [para 21; 32-35; claim 5].

Re. Claim 21 Kwan discloses an issue date field, an expiration date field, a card monetary face value field, a transaction product/service number field , and a transaction date field, each having a one-to-one correspondence with the prepaid card [Figures 4-5; para 75; 93; 69].

Re. Claim 30, claim 30 is rejected with same rational as claim 16.

Art Unit: 3693

Re. Claim 31, Kwan discloses the card comprises a physical card carrying duplicate information carried in the database [Figure 1; para. 21; 63; claim 1], and the card each comprises a serial number, the first-time password number, and an expiration date printed on an exterior surface of the physical card [Figure 1; para 21; 63; claims 1 & 4].

Re. Claim 32, Kwan discloses the database includes a database record corresponding to the card and comprising a serial number field storing a system-assigned serial number, a first-time password field storing the system-assigned first-time password used for a first time validation of the card, and a user-set password field for storing the user-set password reset as the current password number by the user subsequent to each validation of the card, a monetary balance field storing a monetary balance available to the user, and comprising the further step of: subsequent to the validation of the card, a action of subtracting a transaction' price for distribution to a vendor from the monetary balance field to update the monetary balance field by reducing a value of the monetary balance field by the price being subtracted [Figures 2-3; para. 19-21; 32-35; claims 5 & 8].

Re. Claim 33 Kwan discloses an issue date field, an expiration date field, a card monetary face value field, a transaction product/service number field, and a transaction date field, each having a one-to-one correspondence with the card [Figures 4-5; para. 75; 93; 69].

Art Unit: 3693

Claim 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwan and Parrillo as it applied to claims 16 and 20 above, and further in view of Rubin et al (hereinafter Rubin – US 6,701,522).

Re. Claims 22-24, Kwan discloses located between a user and the database, receiving from the user an input of the card serial number and the user input another password (password) number; the portal accessing the database and validating the prepaid card by comparing the received user-input another password (password) number with the next-time password (password) number stored on the database [claim 1], and wherein the portal site is connected to the user and to the database via the Internet and wherein the portal site is connected to the user via a telephone line and (see use of internet and telephone for activation) [para. 60; claim 1]. Kwan or Parrillo does not explicitly disclose portal, or a portal site. However, Rubin discloses this feature [see Abstract; Figures 1-2, 7; col. 1 lines 5-50] to allow a user(s) (purchaser) to customize interested websites, which will be automatically retrieved and display information the user is seeking. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan, Parrillo and include portal, as disclosed by Rubin, to allow the user to configure its favorite's website for obtaining information or purchases.

Re. Claim 25, Kwan discloses wherein the user orally inputs another password (password) number to the portal [para. 60].

Re. Claim 26, Rubin discloses portal site. Kwan, Parrillo or Rubin does not explicitly disclose further receives user input of the serial number and confirms the expiration date of the prepaid card to the database prior to validating the prepaid card. However, this function is well known function of using credit cards. For example, when a customer orders a product online or by phone the merchant asks these questions to properly charge the customer as-will-as validates the card. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan, Parrillo and Rubin and include this function to enhance the security of the card in case it is used improperly.

Re. Claim 29, Kwan discloses wherein the user orally inputs the password number to the portal site and the portal site orally responds to the user, via a telephone call [para. 60].

Claim 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwan, Parrillo and Rubin as it applied to claims 16, 20 & 26 above, and further in view of Novoa.

Re. Claims 27-28, Novoa discloses after validation of the prepaid card, the portal site i) requests the user to input the new user-set next-time password (password) number, ii) receives the new user-set password number from the user, iii) sends the received new

Art Unit: 3693

user-set next-time password (password) number to the database to be stored, in the user-set next-time password/password number field, as the text-time password/password number required for a next validation of the prepaid card and a next successful validation of the prepaid card requires the portal site i) to receive from the user another password number input, 'and ii) to successfully compare the received another password number input with the next-time password/ password number stored in the user-set password number field of the record of the prepaid card within the database [Abstract; col. 2 lines 27-49; col. 3 lines 6-25] to increase the security for unauthorized access to the account since the current pre-paid card have code printed on them and any one can use it if the card is lost or stolen. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Kwan, Parrillo and Rubin and include provisioning for the user to reset password, as disclosed by Novoa, for enhancing the security of the pre-paid card and storing the new password in database for validation of the card to prevent fraud and misuse of the customer pre-paid account.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwan and Parrillo as applied to claims 30 & 32 above, and further in view of Novoa et al. (hereinafter Novoa –US 6,636,973) and Rubin.

Re. Claims 34-35, Novoa discloses a server, located between a user and the database, receiving from the user an input of the card serial number and the currently user input

Art Unit: 3693

password; the portal accessing the database and validating the card by comparing the received user-input password with the current password stored on the database, and after validation of the card, the portal site i) requests the user to input the new user-set password, ii) receives the new user-set password from the user, iii) sends the received new user-set password to the database to be stored, in the user-set password field, as the current password required for a next validation of the card [Abstract; col. 2 lines 27-49; col. 3 lines 6-25] to increase the security for unauthorized access to the account since the current pre-paid card have code printed on them and any one can use it if the card is lost or stolen. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Kwan and Parrillo and include the above steps and provisioning for the user to reset password, as disclosed by Novoa, for enhancing the security of the pre-paid card and storing the new password in database for validation of the card to prevent fraud and misuse of the customer pre-paid account. Rubin discloses portal, or a portal site [see Abstract; Figures 1-2, 7; col. 1 lines 5-50]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan, Parrillo and Novoa and include portal, as disclosed by Rubin, to allow the user to configure its favorite's website for obtaining information or purchases.

Response to Arguments

Applicant's arguments with respect to pending claims and new limitations have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693

Harish T Dass

7/16/07